

REMARKS

Applicants have amended claims 1, 3, 4, 9, 11-14, 24, 25, 30, 31, 37, 38, 46, 48, 52, 59, and 61 and canceled claim 2 without prejudice or disclaimer. Claim 1 has been amended to recite subject matter previously recited in claim 2 and claims 4, 11-14, 24, 25, 37, 38, 46, 48, 52, 59, and 61 have been amended to place them in independent form. Claims 1 and 3-63 are pending.

In the Office Action, claims 1, 11, 21, 22, 30, 50, 51, 54, 60, and 63 were rejected under "35 U.S.C. 102(a and/or e)" based on U.S. Patent No. 6,533,971 to Stess et al. ("Stess"). Stess discloses a method of forming a custom molded orthopedic impression shirt, wherein the method includes first mounting a release shirt or layer on a patient's torso and then mounting a resin-impregnated impression shirt over substantially the entire release shirt. (Col. 2, lines 20-31.) The resin of the impression shirt is allowed to harden and then the hardened impression shirt is removed from the torso. (Col. 2, lines 31-34.) Stess further discloses using a digital scanner 51 to scan the outside or inside of the hardened impression shirt so that an orthosis may be formed. (Col. 6, lines 3-27).

Applicants respectfully submit that the claim rejection based on Stess should be withdrawn because that reference does not disclose or suggest all of the subject matter recited in independent claims 1, 11, and 63. Regarding claim 1, Stess lacks disclosure or suggestion of a "transfer member that includes adhesive material provided on a backing." With respect to claim 11, Stess does not disclose or suggest "placing moldable material in contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin."

In the Office Action, the Examiner apparently asserted that Stess's impression shirt somehow corresponds to a transfer member. In contrast to claim 1, there is no

disclosure of the impression shirt including “adhesive material provided on a backing.” Also, rather than “placing moldable material in contact with the skin . . . ,” as recited in claim 11, Stess discloses mounting the impression shirt over a release shirt without contacting the impression shirt with skin.

Turning to claim 63, Stess lacks any disclosure of a “scanner configured in the form of a scanner for scanning documents.”

Furthermore, with regard to claims 1, 11, and 63, Applicants respectfully disagree with the Examiner’s assertion at page 2 of the Office Action that Stess’s general disclosure of a digital scanner 51 “can be considered an optical image scanner.” Contrary to the Examiner’s attempt to link different definitions from different sources, there is nothing providing an express or inherent teaching of “scanning . . . with an optical image scanner to obtain scanned image data for an image,” as set forth in claim 1. Since the purpose of Stess’s disclosed scanning of the impression shirt relates to proper dimensioning of an orthosis, one of ordinary skill in the art would understand that Stess’s scanner 51 would merely obtain dimensions of the impression shirt rather than obtaining any “image data” for an “image.”

For at least these reasons, the claim rejection based on Stess should be withdrawn.

Claims 1, 2, 21, 22, 30, 49, 50, 52, 53, 58, and 60 were rejected under 35 U.S.C. § 102(b) based on U.S. Patent No. 5,343,536 to Groh (“Groh”).

Groh lacks any teaching of the subject matter of amended claim 1, which recites a “transfer member includ[ing] adhesive material provided on a backing, the adhesive material of the transfer member being placed in contact with skin while the adhesive

material is on the backing.” Groh discloses first applying adhesive to skin and then placing a slide 11 in contact with the adhesive. Col. 4, lines 1-14. That reference lacks any disclosure of a transfer member being placed in contact with skin while adhesive material is on a backing of the transfer member.

Regarding claim 52, Groh does not disclose “scanning . . . a calibration member having one of a predetermined size and a predetermined color.”

Accordingly, the Section 102 claim rejections based on either Stess or Groh should be withdrawn.

Turning to the Section 103 rejections appearing in the Office Action at pages 9-20, Applicants respectfully submit that those rejections should be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. M.P.E.P. § 2143. Second, there must be a reasonable expectation of success. Id. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements and limitations. Id. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) and M.P.E.P. § 706.02(j). The mere fact that a reference is capable of being modified does not provide the sole basis for an obviousness rejection. M.P.E.P. § 2143.01

Claims 1, 12, 14-16, 21, 22, 25-27, 30-32, 50-54, and 63 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent 6,178,255 to Scott et al. ("Scott") in view of U.S. Patent No. 6,355,439 to Chung et al. ("Chung").

Scott discloses a fingerprint scanner. There is simply no reason why one of ordinary skill in the art would have been motivated to use Scott's fingerprint scanner for scanning anything other than fingerprints. Independent claims 1, 12, 14, 25, 52, and 63 recite a "transfer image [that] is not a fingerprint or fingerprints." Therefore, those claims are patentably distinguishable from the subject matter of Scott.

Nothing supports the Examiner's assertion that "it would be obvious to expand the system to include other body parts such as toe prints for the purpose of obtaining and database storing data of scanned image." (Office Action at 11.) Chung concerns a method of obtaining DNA samples. The disclosure of Chung does not provide any motivation or suggestion for using a fingerprint scanner, such as that of Scott, in any manner other than for scanning fingerprints. In particular, Chung does not provide anything supporting the Examiner's assertion that it would have allegedly been obvious to use Scott's fingerprint scanner to scan "other body parts." There is simply no reason why one of ordinary skill in the art would have had any motivation to modify Scott's fingerprint scanner to include any of Chung's subject matter relating to DNA sampling.

In addition to the fact that the claim rejection should be withdrawn because there is no suggestion or motivation for the Examiner's proposed modification, Applicants submit that the claim rejection should also be withdrawn because Scott does not disclose or suggest "scanning [a] transfer image," as recited in claims 1, 12, 14, 25, 52, and 63. In the paragraph bridging pages 11 and 12 of the Office Action, the Examiner

has apparently continued to assert that one or more fingerprint impressions that might remain after touching Scott's platen 72 would somehow correspond to a transfer image. Even if a fingerprint impression might remain on Scott's platen 72 after it is touched, there is no disclosure of scanning that finger print impression. Rather than scanning a print impression left by a finger, Scott discloses directly scanning one or more fingers alone to acquire an optical image of the actual fingers. (See col. 2, lines 8-10, and col. 4, line 39 through col. 5, line 6.) Accordingly, Scott has no disclosure or suggestion of the claimed "scanning" and Chung would have provided no suggestion of that subject matter.

Further, neither Scott nor Chung discloses or suggests "scanning . . . a calibration member having one of a predetermined size and a predetermined color," as recited in claim 52, or a "scanner configured in the form of a scanner for scanning documents," as recited in claim 63, for example.

For at least these reasons, the Section 103 claim rejection relying on Scott and Chung should be withdrawn.

Claims 1-3, 9-26, 30-40, 43-46, 49-59, and 63 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent 6,241,668 to Herzog ("Herzog") in view of FR 2736450 ("FR '450") and Groh.

Applicants respectfully submit that the claim rejection based on Herzog, FR '450, and Groh should be withdrawn because there is no *prima facie* case of obviousness. Herzog's only disclosure relating to scanning concerns the use of a scanner 16 to scan "additional documents, reports, graphics and/or films." Col. 3, lines 32-34. The Examiner continues to allege that Herzog "discloses . . . placing a transfer member in

contact with an external portion of an individual . . . and scanning the transfer image” and that “it is within the scope of [Herzog’s purported] invention to use the scanner for obtaining human scanning information.” Office Action at 12. The Office Action, however, fails to set forth any support for those allegations and does not explain how the Examiner has relied on the FR ‘450 and Groh references.

Contrary to the Examiner’s apparent assertions, FR ‘450 and Groh do not provide any suggestion or motivation to use Herzog’s scanner 16 for anything other than scanning “additional documents, reports, graphics and/or films.” Col. 3, lines 32-34. Applicants do not subscribe to the Examiner’s assertion about subject matter that is allegedly “well known” and/or the subject of “thousands of patents and applications.” Office Action at 12. If the Examiner insists on maintaining the rejection, Applicants respectfully request the Examiner to supply an explanation of how FR ‘450 and Groh are being applied and to also set forth where FR ‘450 allegedly “teaches transferring human data via scanning,” as alleged in the Office Action at page 13.

In addition to the fact that there is no motivation or suggestion to combine the references as proposed by the Examiner, Herzog, FR ‘450, and Groh do not provide any teaching or suggestion of a “transfer member includ[ing] adhesive material provided on a backing,” as recited in claim 1; “moldable material,” as recited in claim 11; a “transfer member [that] is a window,” as recited in claim 12; a “transfer member [that] is one of a hair comb and a hair brush,” as recited in claim 13; “comparing the displayed image to at least one image formed from image data stored in an image database,” as recited in claim 37; “determining a recommendation,” as recited in claim 38; “analyzing

at least one characteristic of a product,” as recited in claim 46; a “calibration member,” as recited in claim 52; or “analysis equipment,” as recited in claim 59, for example.

Claims 1-10, 12, 14-16, 18, 27-30, 38-43, 46-50, and 60-63 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,785,960 to Rigg et al. (“Rigg”) in view of FR ‘450 and further in view of Groh.

Rigg’s disclosure concerns customizing skin foundation products. Applicants respectfully submit that the Section 103(a) rejection based on Rigg in combination with FR ‘450 and Groh should be withdrawn because the Office Action does not establish any reasonable suggestion or motivation for one of ordinary skill in the art to have combined Rigg’s skin foundation product customizing subject matter with the completely different subject matter disclosed in FR ‘450 and Groh. At page 19 of the Office Action, the Examiner admits that Rigg lacks any teaching of an optical image scanner and placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image. Despite those acknowledged shortcomings, the Examiner cites FR ‘450 for the asserted teaching of telemedicine with optical imaging and the Examiner also cites Groh for the asserted teaching of scanning a transfer member with an adhesive. The Office Action, however, does not provide any reasonable suggestion or motivation establishing why one of ordinary skill in the art would have modified Rigg’s foundation customizer to include such asserted subject matter. In light of all of the differences between the subject matter of the cited references, there simply is no reason why one of ordinary skill in the art would have made the modifications proposed in the Office Action.

Further, neither Rigg, nor FR '450, nor Groh supplies any teaching or suggestion of a "transfer member includ[ing] adhesive material provided on a backing," as recited in claim 1; "moldable material," as recited in claim 11; or a scanner "configured in the form of a scanner for scanning documents," as recited in claim 63, for example.

For at least the reasons set forth above, all of the claim rejections should be withdrawn and all of the claims should be allowable.

The claim rejections contain numerous conclusory assertions about certain subject matter being disclosed or being obvious. Applicants do not understand the basis for many of the Examiner's assertions because the Office Action lacks any explanation of how the cited references allegedly disclose such subject matter and/or allegedly render it obvious. If the Examiner insists on maintaining any of the claim rejections, Applicants respectfully request that the Examiner set forth a detailed explanation of the basis for all of the assertions contained in the claim rejection statements.

Applicants respectfully request that the Examiner reconsider the application, withdraw the claim rejections, and issue a Notice of Allowability in a timely manner.

If a telephone conversation might advance prosecution of the present application, the Examiner is invited to contact the undersigned (571-203-2774).

Applicants note that the Office Action contains numerous assertions regarding the pending claims, Applicants' invention, the cited references, purported inventions of the cited references, and alleged "well-known" and/or inherent information, for example. Applicants respectfully disagree with a number of those assertions and decline to


automatically subscribe to any of them, regardless of whether they are specifically identified above.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Anthony M. Gutowski
Reg. No. 38,742